

## REMARKS/ARGUMENTS

Reconsideration of the present application is respectfully requested.

Claims 14 and 16 were objected to for informalities because each purported to depend from itself. These informalities have been corrected by amendments that are believed to have no bearing on patentability.

Claims 1-3 and 5-8 were rejected under 35 U.S.C. §102(b) as being anticipated by U. S. Patent No. Des. 393,972 to Kato (“Kato”). With respect to claim 1, Kato fails to disclose, inter alia, rib means for cutting into a wall as the body is advanced into a hole in the wall, as recited by claim 1. Claims 2-3, and 5-8 depend from claim 1 and are patentable for at least the same reasons as claim 1. Furthermore, additional reasons support the patentability of the various dependent claims. For example, with respect to claim 2, Kato does not disclose a recess formed in the holder and a latch disposed within the recess, as recited in claim 2.

Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. Des. 393,972 to Kato. Claim 4 depends from claim 1 and is patentable over Kato for at least the same reasons as claim 1.

Claim 9-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. Des. 393,972 to Kato and U.S. Patent No. 4,444,359 to Butler (“Butler”). This rejection is respectfully traversed.

In a §103 rejection, the initial burden is on the Examiner to establish a *prima facie* case of obviousness which requires the following: “First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be

a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.” In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (cited for this proposition in MPEP §2142)

Regarding the first requirement for *prima facie obviousness*, The suggestion/motivation to combine or modify under §103 needs to be specific. Where a “statement is of a type that gives only general guidance and is not specific as to the particular form of the claimed invention and how to achieve it ... [s]uch a suggestion may make an approach ‘obvious to try’ but it does not make the invention obvious.” *Ex parte Obukowicz*, 27 USPQ2d 1063, 1065 (U.S. Pat. And Trademark Of. Bd. of Pat. App. & Interferences 1993) (citations omitted).

The Office Action gives no specific motivation, suggestion, or other reason to modify the combination of Kato and Butler to meet the claimed dimension. Rather, the rejection is predicated on the general idea that “one of ordinary skill in the art would have been expected to routinely experiment to determine the optimum dimensions for a particular use.” An alleged expectation of routine experimentation gives only general guidance and is not specific. This is tantamount to an obvious-to-try argument. Furthermore, there any suggestion or motivation for the proposed modification in the references themselves. In fact, there is no apparent basis for the alleged motivation or suggestion, and clarification and a specific source for its existence are requested. For at least this reason, the Office Action fails to establish a *prima facie* case of obviousness.

A second reason that the present § 103 rejection fails is that the explicit teachings of Butler are contrary to the claimed dimensions of claims 9-19. In particular, Butler states:

The recess 34 in the panel 30 for receiving the toilet roll receptacle 10 is sufficiently deep where space is provided between walls using 2x6 studs, but in an exterior wall where 2x4 studs 39 are used, **the recess 34 will extend beyond the extremity of the 2x4 stud and the toilet roll receptacle 10 will have its back wall 24 extending into a conventional air space 40** between the insulation or sheeting 41 such as "Celotex" and the exterior facing or brick and mortar structures 42 shown in FIG. 3.

See, Butler Column 2, line 65 – Column 3, line 6 (emphasis added). Thus, the teachings of Butler explicitly contradict the modification proposed in the Office Action. For this additional reason, it is improper to combine Butler with Kato and further modify the combination as proposed in the Office Action.

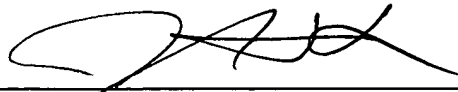
Dependent claims 10-14 depend from claim 9, and are patentable for at least the same reasons a claim 9. Dependent claims 16-19 depend from claim 15, and are patentable for at least the same reasons a claim 15.

For the foregoing reasons withdraw of the § 103 rejection for claims 9-19 is requested.

New dependent claims 20-24 are also believed to be patentable.

In view of the foregoing it is submitted that this application which includes claims 1-19 are in condition for allowance. Consideration of an allowance at an early date is requested. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning this application.

Respectfully submitted,



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